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| 10/064,350 | 07/03/2002 | Timothy R. Hawes | 71234-46 | 9613 |
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| MCGARRY BAIR PC 171 MONROE AVENUE, N.W. SUITE 600 GRAND RAPIDS, MI 49503 | | | EXAMINER VANAMAN, FRANK BENNETT | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3618 | |

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,350

Applicant(s)

HAWES, TIMOTHY R.

Examiner

Frank Vanaman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10, 13-17, 19, 20, 25-27 and 30-37 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 18, 21-24, 28, 29 and 38-51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/3/02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Application

1. Applicant's amendment, filed April 19, 2004, has been entered in the application. Claims 1-7, and 9-51 are pending, claim 8 having been canceled.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the 'threaded plate' adapted to abut the vehicle frame (see claim 20, as now amended) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The current drawings do not show an element which abuts the vehicle and comprises a threaded plate as now claimed.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 20, as now amended, refers to a threaded plate which abuts the vehicle. The specification fails to refer to any element which abuts the vehicle as being a threaded plate. Note the description of element 132, termed a "bracket" in

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the specification, and which includes an opening 180 which "can be threaded if desired" (page 8) but fails to refer to the bracket as being a threaded plate.

Claim Objections

4. Claims 10-12 are objected to because of the following informalities: these claims are written to depend from claim 8 which has been canceled. In view of no claim being substantially the same as canceled claim 8, these claims are being treated as including the subject matter of the canceled claim, as best understood. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 20, line 2, there is no antecedent basis in the claim recitation for a 'the threaded plate'.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-7, 9, 10, 13, 14, 25, 26, 27, 31, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zieske (US 5,950,975, cited by applicant) in view of Laubach (US 5,895,064). Zieske teaches a fender mount and bracket system for a vehicle having a longitudinal frame (figure 2) and inherently understood to include ground-engaging support wheels on lateral sides of the frame, including a fender (40) of 'relatively linear' cross section, with upper and lower surfaces, and an elongated support arm (20a, 20b) mounted to one of the upper and lower surfaces of the fender, having a longitudinal axis (25) and a bracket (24, 26) mounted to the arm, having a connection to the frame (28, 42) which may be replaced with a threaded aperture which receives a bolt (see col. 4, lines 15-23), the frame connection allowing rotation about a further longitudinal axis (48) spaced a fixed distance from the first longitudinal axis (25), further including a ring clamp connection (30: 32, 34, 36, 38) which connects a bracket (e.g., 32) to the arm (at 20a), the ring clamp and arm having complimentary sized circular dimensions. The reference to Zieske fails to teach the distance between the first and

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second longitudinal axes as being adjustable, through a two-bracket scheme, employing a fastener and a plurality of elongated openings. Laubach teaches a distance adjusting system for a mount for a vehicle, including a first bracket (36) and a second bracket (34), both having a channel-shaped cross section, wherein the linkage between the brackets is adjustable through the use of first and second bolts (52, 54) extending through plural complimentary first and second elongated openings (48, 48', 50, 50') and secured with nuts (56, 58) to allow lengthwise adjustment of the linkage and relative vertical motion therebetween. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the offset between the longitudinal axes defined by Zieske adjustable as taught by Laubach, for example by replacing the central section (20, between 20a, and 20b) of the mount taught by Zieske with the dual bracket system taught by Laubach, for the purpose of allowing a more precise fit—for example so that a single adjustable bracket system may be used with a plurality of vehicles and tire sizes.

As regards the particular shape of the nut, both square and hex nuts, having a footprint comprising 4 and 6 linear edges, respectively, are very well known in the fastening fields and as such it would have been obvious to one of ordinary skill in the art at the time of the invention to use a square nut in place of the hex nut taught by Laubach for the purpose of providing a nut having a greater surface area on its wrench-engaging portions.

As regards the particular surface area of the nut, it is well known in the fastening arts to adjust the engaging faces of fasteners to provide a desired clamping force on a particular piece of material, and it would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the size of the nut to create a desired level of clamping of the two elements.

As regards the provision of the nut as having an overall base width substantially equal to the channel width (claims 8 and 9), inasmuch as it is known to provide accommodating recesses for nuts to hold them from turning while a fastener is tightened from the opposite side of the materials being connected, it would have been obvious to one of ordinary skill in the art at the time of the invention to size the nuts taught by Laubach to be substantially equal to the channel width of the brackets for the

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purpose of allowing the fastener assembly to be tightened from one side, thus obviating the use of a wrench to provide back-up force on the nut while tightening the fastener.

8. Claims 15, 16, 17, 19, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zieske in view of Laubach and Laribee (US 4,181,293). The references of Zieske and Laubach are discussed above and fail to teach the mating faces of the brackets (Laubach's 34 and 36) as having mating serrated faces on opposite sides of the elongated fastener receiving openings. Laribee teaches a bracket-to-bracket assembly including at least one threaded fastener assembly (31, 32) extending through elongated holes (22, 29) in a pair of brackets (13, 14), two sets of serrations (21, 30) are provided, each set being divided on opposite sides of the elongated openings to define two distinct sets of serrations in the region of the openings. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide mating serrated faces as taught by Laribee on mating faces of the two brackets of Zieske as modified by Laubach, for the purpose of insuring that a particular configuration of the two brackets is positively maintained.

As regards claim 19, the reference to Laribee teaches that each bracket portion (13, 14) has a plate-shaped face, and it would have been obvious to one of ordinary skill in the art at the time of the invention to make the mating brackets plate shaped to allow for slight offsets in the position of the bracket portions connected to the vehicle frame and fenders, and to prevent them from locking if slightly angularly misaligned.

9. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zieske in view of Laubach and Len'g'd. Kalinin Poly (SU 925,727). The references of Zieske and Laubach are discussed above and fail to teach a vibration decoupling connector between the fender and arm. Len'g'd. Kalinin Poly teach a fender (9, 11) having at least one vibration decoupling spring (22) connecting the fender (9, 11) to a mounting element (19). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a spring as taught by Len'g'd. Kalinin Poly to mount the fender

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to the arm of Zieske as modified by Laubach, for the purpose of reducing vibration in the assembly, and biasing it to a desired position.

Allowable Subject Matter

10. Claims 18, 21-24, 28, 29, and 38-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claim 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claims 11 and 12 are objected to as being dependent from a canceled claim but would be allowable, as best understood, to include the material of that canceled claim.

Response to Comments

13. Applicant's comments have been carefully considered. As regards applicant's comments directed to the use of the term 'relatively', the examiner notes applicant's preferred definition for the term "not absolutely but substantially", and will apply such definition to the term 'relatively' as noted. The examiner notes applicant's use of 'relative' in claim 2, line 3.

Applicant has argued that the reference to Zieske is complete and needs no further adjustments, however the scheme taught by Zieske does not allow a change of the distance between the two axes, which would be provided by the provision of the length adjustment taught by Laubach.

Applicant has argued that structural incompatibilities would make the combination of Zieske and Laubach untenable, however the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Laubach has

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been relied upon for the teaching of the utility of length adjustable linkage which Zieske lacks.

In response to applicant's argument that the references must explicitly provide a suggestion for combining, a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish* 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)); further, references may be combined although none of them explicitly suggests combining one with the other (see *In re Nilssen* 7 USPQ2d 1500 (Fed. Cir. 1989)). It has long been the law that the motivation to combine need not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

The motivation to combine can be found either in a prior art reference, or it can be implicit in the knowledge of one of ordinary skill in the art. See *In re Huston*, 308 F.3d 1267, 1280 (Fed. Cir. 2002); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997).

Sources suggesting a combination may be: (1) the combined teachings of the prior art, (2) the knowledge of the ordinary practitioner and (3) the nature of the problem to be solved. "The test for implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000).

In *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Company*, No. 03-1333 (Fed. Cir. January 29, 2004), the court emphasized that an "express written teaching in the art" to combine references was not required [emphasis added]. Rather, motivation may come from "the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem."

Please further note the following from Section 2144 of the MPEP: "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent...The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem...It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant." Also Chief Judge Nies writes in a concurring opinion, "While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or the prior art specifically suggest making the combination...In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference". See *In re Oetiker* 977 F.2d 1443, 24 USPQ.2d 1443 (Fed.Cir.1992).

Please note that the motivations for making the combinations are specifically set forth in the rejections.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's comments concerning the decoupling device and the Soviet reference are noted. To the breadth claimed, the spring element meets the limitation of being a decoupling device. Applicant has referred in the arguments to specific characteristics which applicant appears to desire to ascribe to the coupling device, however these limitations are not recited in the claims as written. Although the claims are interpreted in light of the specification, limitations from the specification are not read

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into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant is reminded that an examiner interpreting claims is not allowed to read unclaimed limitations into the claims. During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 703-308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-1113.

As of May 1, 2003, any response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,

Or faxed to one of the following fax servers:

Regular Communications/Amendments: 703-872-9326
After Final Amendments: 703-872-9327
Customer Service Communications: 703-872-9325

F. VANAMAN
Primary Examiner
Art Unit 3618



Handwritten signature of F. Vanaman, dated 7/8/04.